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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS CAMERON DOHERTY, CARLIN DOMBUSH, and DAVID FARBER

Appeal 2014-008102
Application 12/905,755[1]
Technology Center 3600

Before MICHAEL C. ASTORINO, NINA L. MEDLOCK, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] The Appellants identify 34 Solutions, LLC as the real party in interest. Appeal Br. 3.

ILLUSTRATIVE CLAIM

1. A method for electronic purchasing via a mobile web-enabled communication device including an Internet browser, the method comprising:

creating a contacts list, stored on the mobile device, containing at least one shipping address;

creating a payment file, stored on the mobile device, containing encrypted credit card information including a card number and expiration date for at least one credit card;

displaying, via the browser, a merchant website including a web page displaying an order button;

placing the item to be purchased in an order list on the web page;

selecting the order button to cause item information including the name and price of a selected item to be purchased to be sent from the merchant website to the device;

requesting the price of the selected item from the merchant website;

receiving the price of the selected item from the merchant website;

in response to receipt of the item information from the merchant website:

selecting a specific one of the credit cards and a specific one of the shipping addresses from the contacts list and the payment file, respectively;

decrypting the credit card data for the selected credit card; and

sending the decrypted credit card data and the selected shipping address from the device to the merchant website for order processing.

REJECTION

Claims 1–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wong et al. (US 2012/0143752 A1, pub. June 7, 2012) ("Wong") and Kim et al. (US 2008/0249948 A1, pub. Oct. 9, 2008) ("Kim").

FINDINGS OF FACT

We rely upon and adopt the Examiner's findings stated in the Final Office Action at pages 2–8 and the Answer at pages 2–9. Additional findings of fact may appear in the Analysis below.

ANALYSIS

Independent claims 1, 6, 10, and 15 are argued as a group. Appeal Br. 10–13. Claim 1 is selected for analysis herein. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Appellants present two arguments for Examiner error in the rejection of claim 1, each of which is addressed below.

As explained below, the Appellants' arguments for claim 1 are not persuasive. Accordingly, we sustain the rejection of independent claims 1, 6, 10, and 15, as well as the rejection of dependent claims 2–5, 7–9, 11–14, and 16–20, (the Appellants relying only upon the arguments presented for the respective independent claims (*see* Appeal Br. 14)).

1. "*expiration date*"

Claim 1 recites, in part:

> creating a payment file, stored on the mobile device, containing encrypted credit card information including a card number and expiration date for at least one credit card; . . . and
>
> sending the decrypted credit card data and the selected shipping address from the device to the merchant website for order processing.

According to the Examiner, Wong teaches storing and sending the credit card expiration date, because it describes storing "shipping address, card alias, secure token, etc." on a mobile phone. Answer 7 (quoting Wong ¶ 31); *see also* Final Action 5, 7 (citing Wong ¶¶ 29, 31). The Examiner finds that an expiration date is an inherent property for credit card transactions and that there is nothing in the claim that distinguishes the "card alias" mentioned in Wong from the "actual credit card number" (although the Examiner appears to intend to refer to the expiration date). Answer 7. Moreover, the Answer states that it would have been "notoriously obvious" to one of ordinary skill in the art to replace Wong's alias number with the "actual credit card number" (again, appearing to intend to refer to the expiration date). *Id.* at 7–8.

In addition, the Examiner finds that Kim also discloses the storing and sending the credit card expiration date, through its disclosure of a "valid date." Answer 8 (citing Kim ¶ 25).

The Appellants argue that Wong discloses neither storing a credit card expiration date on a mobile device, nor sending a card expiration date to effect the purchase of an item. Appeal Br. 10–11 (citing Wong ¶¶ 29, 31, 37, 38). According to the Appellants, neither the "card alias," nor any of the other data Wong identifies stored on a mobile device, constitutes an "expiration date." *Id.* at 11.

The Appellants further contend that storing the expiration date is not inherent in Wong (or in Kim) because there is no evidence that the stored expiration date is necessarily present — notwithstanding the Appellants' concession that the credit card expiration date may be necessary to effect a transaction. Reply Br. 2–3.

The Appellants also argue that Kim does not disclose the stored expiration date, as claimed, because Kim's "valid date" "more logically refers to the date of transit, as that information would likely be of interest" in the context of Kim's disclosure of using a mobile phone for payment of bus or subway fares. *Id.* at 2.

As to Wong, we agree with the Appellants that there is no disclosure of a stored "expiration date" in Wong and no basis for the inherency of such a feature. Although the Examiner finds (and the Appellants admit) that the expiration date is necessary for credit card transactions, such does not necessarily require the expiration date to be stored on a mobile device, as claimed. However, the Appellants do not respond to what we understand as the Examiner's determination (*see* Answer 7–8), as discussed above, that it would have been obvious for a person of ordinary skill in the art to include the expiration date among the data stored on Wong's mobile phone. Therefore, the Appellants present no basis for error in this determination.

Furthermore, the Appellants' argument that Kim fails to teach the stored expiration date is also unpersuasive. As an initial matter, the Appellants' assertion (Reply Br. 2) that, rather than constituting an expiration date, Kim's "valid date" "more logically refers to the date of transit, as that information would likely be of interest," rests on speculation. Moreover, Kim discloses that the purpose of the "valid date" is not limited to the transit-fare context. Kim (¶ 25) states that "a financial authority such as a card company or a bank transmits information . . . including a customer's number and a valid date of a card to be issued to a card issuance applicant" — a situation independent of payment for transit.

2. "*order button*"

Claim 1 recites, in part:

> selecting the order button to cause item information including the name and price of a selected item to be purchased to be sent from the merchant website to the device.

According to the Examiner, "all online checkouts and payments" display the items purchased and their respective prices — such functionality being shown in the description of Wong's checkout button. Answer 9; *see also* Final Action 5–6 (citing Wong ¶ 32).

The Appellants dispute this finding, arguing that "[t]he instant claim limitation is particularly significant," because

> the present system *combines the product price and description information with the payment/shipping information held within the mobile device, allowing the consumer to verify, on a single screen, all components needed to complete a purchase.*

Appeal Br. 13. Further, in the Reply Brief, the Appellants argue:

> [T]he claimed "order button" cannot be equivalent (or similar) to a "checkout button", as asserted by the Examiner, because when a 'checkout' button is selected, the items to be purchased have — by necessity — already been displayed on the mobile device, and in distinction, when Applicants' claimed "order button" is selected, the *item information including the description and price of a selected item to be purchased is THEN sent from the merchant website to the device.* Thus the two types of buttons cannot possibly have the same function.

Reply Br. 5. The Reply Brief emphasizes that the "***claim recites a different sequence of operations than that disclosed in the Wong reference.***" *Id.*

The Appellants' reasons for distinguishing the claim from Wong rely upon features that are not set forth in the identified language of claim 1.

Contrary to the Appellants' assertion, the claimed features do not require the user to "*verify, on a single screen*," the product price, description, and payment/shipping information. *See* Appeal Br. 13. Indeed, claim 1 does not require any items to be displayed anywhere, let alone "*on a single screen*," nor does the claim describe any mechanism for a user to "*verify*" anything, as the Appellants allege. *See id.* Further, establishing the shipping information is set forth in a separate limitation of claim 1, which requires "selecting . . . a specific one of the shipping addresses from the contacts list." Appeal Br. 16, Claims App.

Nor does claim 1 require "***a different sequence of operations than that disclosed in the Wong reference***" (Reply Br. 5) as the Appellants contend, whereby the "item information" is "sent . . . from the merchant website to the device," as alleged. Indeed, the Specification explains that the mobile device displays the product information (which would include the price) ***before*** activating the "order button":

> To make a purchase, the user first displays a web page on a merchant's website using web browser 104 on mobile device 101. After the user selects the item(s) to be purchased by placing the item(s) in an order list, such as a 'shopping cart' or the like, an order button 112 on the web page is selected ('clicked on') to initiate the purchasing transaction, at step **204.**

Spec. ¶ 11. Because it is an aspect of a preferred embodiment, the approach of displaying product information before activation of the "order button" would not be inconsistent with the claim.

In addition, the Appellants concede that Wong performs the claimed function, but allege that it occurs before — rather than after — activating Wong's checkout button:

> [T]he claimed "order button" cannot be equivalent (or similar) to a "checkout button", as asserted by the Examiner, because when a 'checkout' button is selected, the items to be purchased have — by necessity — already been displayed on the mobile device.

Reply Br. 5. Thus, rather than distinguishing Wong, the Appellants merely contend that a different instrumentality of Wong — i.e., other than the checkout button — meets the claim limitation at issue.

DECISION

We AFFIRM the Examiner's decision rejecting claims 1–20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED